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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 42P8387

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on September 16, 2005

Signature: [signature]

Typed or printed name: Adrian Villarreal

Application Number	Filed
09/533,048	March 22, 2000

First Named Inventor: Jay H. Connelly

Art Unit	Examiner
2153	Barqadle, Yasin M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 46,149
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

[signature]
Signature

R. Alan Burnett
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Telephone number

September 16, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Response pursuant to 37 C.F.R. § 1.116 -- Expedited Procedure
Examining Group 2100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Jay H. Connelly	)	Examiner: Barqadle, Yasin M.
	)	
Serial No. 09/533,048	)	Art Group: 2153
	)	
Filed: March 22, 2000	)	
	)	
For: SIGNALING METHOD AND APPARATUS TO PROVIDE CONTENT ON DEMAND IN A BROADCAST SYSTEM	)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Responsive to the Final Office Action mailed June 16, 2005 and in concurrence with the Applicant's Notice of Appeal filed herewith, the Applicant request the Examiner reconsider all pending claims in view of the following remarks.

REMARKS

These remarks are in response to the Final Office Action dated June 16, 2005. In the Final Office Action, the Examiner rejected claims 1, 6-7, 9-11, 14-15, 19, 21-23, and 25-30 under 35 U.S.C. § 102(e) as being anticipated by Herz *et al.*, U.S. Patent No. 6,088,722 (hereinafter *Herz*). Claims 2-5, 12, 13, 16, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Herz*, in view of Payne *et al.*, U.S. Patent No. 6,021,433.

With respect to each of independent claims 1, 11, 15, and 27, Applicant respectfully asserts that *Herz* does not disclose selecting data files described by meta-data to store based on ratings generated for the data files, or store such selected data files when they are broadcast on a client system.

Herz discloses a system and method for scheduling broadcast of and access to video programs and other data using customer profiles. As stated in the Abstract (in pertinent part), *Herz* discloses,

> A system and method for scheduling the receipt of desired movies and other forms of data from a network, which simultaneously distributes many sources of such data to many customers, as in a cable television system. Customer profiles are developed for the recipient describing how important certain characteristics of the broadcast video program, movie, or other data are to each customer. From these profiles, an "agreement matrix" is calculated by comparing the recipient's profiles to the actual profiles of the characteristics of the available video programs, movies, or other data. The agreement matrix thus characterizes the attractiveness of each video program, movie, or other data to each prospective customer. *"Virtual" channels are generated from the agreement matrix to produce a series of video or data programming which will provide the greatest satisfaction to each customer.* (Emphasis added)

Under *Herz*, there is no storing of data files (pertaining to video programming content that is broadcast by the server system – *e.g.*, a movie or TV show). Rather, a virtual channel is generated (from an agreement matrix) that includes programming that user(s) (customers) of a given set-top multimedia terminal (*i.e.* box) are determined most likely to be interested in. The virtual channel, in effect, is a channel that includes programming that is determined to be of most interest to the customer for a given timeslot. In fact, the same programming is also available on it's original intended

channel, so the virtual channel does not add any program content that would otherwise not be received. Rather, the virtual channel, if perfect, would identify the program content a customer would most like to see from among all of the content available for a particular timeslot from a broadcast system (*e.g.*, cable or satellite service) without requiring the customer to "surf" through all of the available program options for that timeslot (see Col. 1, lines 45-54 and Col. 3, lines 15-23 of the Background of the Invention section).

Overall details of the *Herz* process are shown in Figures 1 and 2, and generally described in columns 25-27. In further detail, *Herz* states,

> The content profiles received with the electronic program guide data are preferably stored at the set top multimedia terminal and compared by the set top multimedia terminal to the customer profiles for each customer. An agreement matrix is then created at step 106 using the techniques described above. Once the agreement matrix has been generated, those programs with the highest values for ac, i.e., the closest distance (1/ac) and hence closest match to the customer's profile or profiles, *are prioritized and selected for presentation as "virtual channels"* (in the case of creating "virtual channels" at a set top multimedia terminal) or as the programming channels (in the case of scheduling video programming at the CATV head end) at step 108. This process is described in more detail herein with respect to FIG. 2. (Col. 26, lines 5-19, emphasis added)

and

> FIG. 2 illustrates a technique for selecting video programs for "virtual channels" at the customers' set top multimedia terminals or, alternatively, for scheduling video programming at the head end from the available video programming sources. As illustrated, the method is initialized at step 202 by determining which customer profile or profiles are active *for the time period to be scheduled*, by determining the customers' appetites (number of channels available for transmission), and by determining the database of video programming from which the schedule may be created. For example, at the head end, the video programming database may be any video programming available for transmission during the designated time frame, while at the set top multimedia terminal, the video programming database comprises only the video programming on those channels which the customer is authorized to receive.
>
> Once the agreement matrix for the available video programs has been determined, at step 204 the most popular programs for a single customer (at the set top multimedia terminal) or a cluster of customers (at the head end) are selected and removed from the list of available

programs during the *relevant time interval.* ***Of course, in the case of scheduling at the set top multimedia terminal, the video programs scheduled onto "virtual channels" are still received on their regular channels and the "virtual channels" are assigned to unused channels of the set top multimedia terminal.*** (Col. 26, lines 38-64)

With respect to the Applicant's argument that "Herz provides no means for storing video programming," the Examiner states, "Herz provides means for storing a video program and the associated content files at the set top multimedia terminal 620 such as memory 902, 904, and 908, fig. 0 and col. 46, lines 51 to col. 47, line 24." This cited text recites (in relevant part):

> FIG. 9 illustrates a software block diagram of an embodiment of a multimedia terminal 620 for use in the one-way and two-way system embodiments described above. As illustrated, the video program material and the associated content profiles are received at the set top multimedia terminal 620 from the head end 408. ***A program list*** *indicating those video programs which the user of that set top multimedia terminal 412 has available and is authorized to receive is* ***stored in memory 902****. The associated* ***content profiles (program characteristic lists)*** *is preferably received with the electronic program guide data and* ***stored in memory 904****. ...*
>
> *From the agreement matrix determined by processor 906 and* ***stored in memory 908****, a list of "preferred channel selections" or "virtual channels" is determined.* An electronic program or display guide 914 listing the available selections is provided. In accordance with the invention, the display guide 914 is either modified to include fields for the "virtual" channels, or else the recommended programming is highlighted in an obvious manner or reordered for the customer's perusal and selection of the desired programming. Once the customer has selected the desired virtual channel from a highlighted program guide or a listing of the programs available on the virtual channels using the customer's remote control unit, processor 906 then accordingly instructs channel selector 912 to tune the channels for the programming determined in accordance with the techniques of the invention to be most desirable to that customer.

It is clear that *Herz* provides no means for storing data files comprising video programming content. As shown by the multimedia terminal software block diagram of Fig. 9, there is no block related to storing video programming content. Furthermore, there is no storage device for storing video programming content in the multimedia terminal hardware block diagram of Fig. 10. The only means via which any data may

be stored is memory 1012, which is used to store "The customer profile data and/or records of the viewing habits of the customer." (Col. 48, lines 22-24). Clearly, there is no means for storing the actual data files, nor is such use disclosed in *Herz*.

If the data files were to be stored on board the *Herz* set-top box in memory 902, 904, 908 or memory 1012, a huge portion of memory would be needed, such as 20+ gigabytes. (By comparison, today's PVRs typically provide at least 40+ gigabytes of hard disk storage to store data files). The cost of even 1 gigabyte of memory at the time of the *Herz* invention (~1995) would have been on the order of $1000 or more. In fact, *Herz* discloses techniques for *minimizing* the amount of memory required by reducing the amount of EPG data provided to the customer (see Col. 42, line 64 to Col. 43 line 15).

If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact the undersigned attorney at (206) 292-8600.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: Sept 16, 2005

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on September 16, 2005
Date of Deposit

Adrian Villarreal
Name of Person Mailing Correspondence

Signature

September 16, 2005
Date